

April 21, 2001

United States Patent and Trademark Office
Box 4
United States Patent and Trademark Office
Washington, DC 20231

Attention: Mr. Jon P. Santamauro

Subject: Comments on Patent Law
Harmonization for SCP

Dear Mr. Santamauro:

To your request for comments on global harmonization efforts of the Standing Committee on Law of Patents (SCP) I offer the following:

(Item numbers refer to the numbering system employed in the Federal Register/ Vol. 66, No. 53/ Monday, March 19, 2001/ Notices -- Pages 15409, 15410 and 15411.)

Item 1. (First to File Rule vs. First to Invent System)

The request for comments regarding this issue appears to be restricted to *"which standard is the 'best practice' for a harmonized global patent system."*

Therein may lie the basis for so much controversy between the "little guys" and the "big guys" issues; the assumption that global patent law harmonization requires a **standard**, as in "one size fits all."

If we must assume that our U.S. patent law system be harmonized globally, perhaps considering the framework, or example, for said global structure may lie outside patent law; say in the fields of medicine, family, or tax law. When governments can co-exist in harmony with different laws regarding the dispensing of medication, or tax regulations, for example, it would seem quite possible to do so with different and self serving patent laws as well.

The foreign First to File Rule would appear to favor multinational businesses who must be international players by the nature of their operations. The First to Invent System, however, has well served the independent inventor who has limited resources and does not pursue markets outside the U.S.

It is therefore proposed that a system encompassing the present U.S. First to Invent System be maintained, but expanded to recognize the diverse identity of intellectual property tied to global marketing, and tied to domestic marketing -- but holding both to a "market specific" prior art recognition. For example, the pharmaceutical industry could freely embrace global harmonization by adopting

relevant foreign patent law standards, without dragging the American independent inventor along with it. The small independent inventor should not be paranoid about global prior art when his marketing goal is solely domestic. Each defined category of patentee should answer to their own relevant section of patent law.

This proposal is not without some precedent. The U.S. has had to adapt to other changing legal demands, that address dissimilar constituencies, in the past. I'm mindful of corporate tax laws vs. personal tax laws, parochial schooling vs. public schooling, interstate licensing vs. intrastate licensing, and utility patents vs. design patents, to name a few. All operating in harmony within the overall structure of a government system.

To sum up: Create a section of U.S. patent laws and exemptions specific to U.S. independent inventors and allow multinational businesses freedom to pursue patent laws that embrace global harmonization. Such an updated patent law system could very well put an end to the bickering and animosity that exists today between independent inventors and multinational corporations. If recognizing the special needs of multinational interests is to be addressed at all, then creating a section of patent laws to allow them to be the global players they already are seems mandatory.

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Item 10. (Geographical restrictions defining prior art)

Because of the freedom extended U.S. independent inventors to file patent applications *pro se.*, the patentability search for prior art is customarily limited to patents of record in the U.S. Patent and Trademark Office.

Since independent inventors' commercialization of a U.S. patent relies solely on U.S. patent laws for infringement defense within the U.S., it then follows that granting of letters patent from the U.S. PTO should not allow foreign patents to be considered prior art, nor should foreign prior art be the basis for invalidating a U.S. patent by a small independent inventor. Elimination of geographical restrictions that define prior art would place an undue hardship on U.S. independent inventors whose limited resources preclude global patentability searching prior to a U.S. patent application.

To sum up: No published patent documentation should invalidate a patent, except those which are published within the jurisdiction of the issuing patent office.

Note: Maintaining geographical limitations for recognizing prior art would permit duplicate patent coverage in foreign countries, agreed, but when viewed in the context of commercialization it makes economic sense.

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Item 17. (Patent applications filed in name of inventor(s) only)

To consider potential patent law harmonization with global partners, recognition of the difference between global and domestic patentees seems imperative.

Allowing assignees, or large business creators of intellectual property to file patent applications under the name of the "end user" would be a step toward separating the prior art effects on patent applications by different categories of patentees.

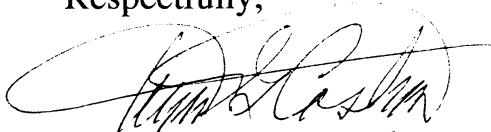
To sum up: Yes, allow assignees to file patent applications directly.

Note: Independent inventors usually have no need to consider who will own their patent until well after the fact. At that time, the assignee would be free to conduct a global patentability search before entering into a license agreement. The assignee, by becoming a matter of record in the PTO would then be governed by their own section of patent laws if they happened to be a multinational business.

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One final comment: The separation of multinational, large entity, and independent inventors, as categories with different patent law treatment, may seem radical, but in order to maintain a global leadership position of uniqueness -- perhaps its time has come.

Respectfully,



Don G. Costar, Founder,  
Nevada Inventors Association